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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,611	12/17/2001	Yuki Sasaki	111482	5891

25944 7590 12/15/2006

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EXAMINER	
WILLIAMS, LEONARD M	
ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/015,611	SASAKI ET AL.	
	Examiner	Art Unit	
	Leonard M. Williams	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-17 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Detailed Action

Response to Pre-Appeal Brief

In response to the Pre-Appeal Brief filed 8/17/2006 a decision to reopen prosecution was made. The examiner has examined the points set out in the Pre-Appeal Brief and has further elucidate the rejections of the Final Office action of 5/17/2006, specifically addressing any issues of non-analogous art in the response to arguments section and additional issues within the rejections themselves. This action is **non-final**.

Status of Claims

The request for reconsideration of the office action dated 11/30/2005 has been entered and considered. The arguments presented are addressed below. No amendments have been made to the claims. Claims 1-17 are examined herein.

Response to Arguments

Applicant's arguments filed 2/28/2006 have been fully considered but they are not persuasive. The applicant's have asserted that the compound as set forth in Ishiyama patent does not teach or suggest the currently claimed compounds. In support of this the applicant's have stated that the inclusion of the terms "consisting essentially of" sets the applicants claimed compound as being distinct from the Ishiyama compound as the Ishiyama compound includes a coloring agent. The

applicants refer to the declaration filed 3/16/2005 wherein resin particles containing colorants were produced as supporting evidence.

The examiner respectfully points out first that this is a composition claim and as previously pointed out in the prior office action the insertion of "consisting essentially of" is to be construed as "comprising" when no clear indication in the specification or claims of what the basic and novel characteristics actually are. The examiner maintains the position that even if a colorant is included in the Ishiyama composition it does not make the resin detailed in Ishiyama different from the currently claimed resin, and further as the resins are equivalent the inherent properties of the Ishiyama resin and currently claimed resin are identical whether the colorant is present or not. There is no clear evidence that the colorant materially affects the inherent properties of the Ishiyama resin and further the colorant(s) claimed by Ishiyama are co-extensive with the "pigments" disclosed on page 22 of the present specification for use with the resin as claimed (particularly co-disclosed "colorants"/"pigments" include carbon black, iron oxide, titanium oxide, talc etc..), thus even if the "consisting essentially of" language is not considered as "comprising" the colorant would not be considered as a materially necessary component. Further Ishiyama discloses in col. 10 lines 1-37, the various colorants to be used in the invention and states that the coloring agent may be used singly or as a mixture, as well as in the form of solid dispersion. Additionally, Ishiyama describes the preparation of resin fine particle dispersions in col. line 55 to col. 14 line 25, with no inclusion of a colorant thus the resin fine particle dispersions are clearly described and exemplified in an embodiment where the colorants are not present.

In response to applicant's argument that Ishiyawa and Hagi are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the current claims are drawn to compositions containing a resin which is identical to the resin detailed in Ishiyawa. As such, the fact that the Ishiyawa and Hagi patents are drawn to toner compositions and the current application is drawn to cosmetic compositions is not non-analogous in the sense that the compositions are utilizing the same materials. Even the colorants disclosed by Ishiyawa are identical to many of the pigments disclosed as possible for use by the applicant's (see specification page 22).

For the reasons detailed above and stated in the prior office action the 102(b) and 103(a) rejections are maintained. The rejections and response to arguments of the prior office action are reproduced below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 6-10, and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishiyama et al. (USPN 6080519).

Ishiyama et al. discloses a binder resin for use in a toner, said binder resin having a volume average particle diameter in the range of 2 to 9 microns, a diameter distribution coefficient GSDv of 1.30 or less, and a number average particle diameter distribution coefficient GSDp of 0.95 or more (col. 3, line 11-col. 4, line 7). The particles are taught to have a shape factor SF1 in a range of from 110 to 140 (col. 4, lines 8-12). A resin with a mean particle diameter of 160 nm, a glass transition point of 58° C, and a weight average molecular weight of 35,000 is specifically disclosed (col. 14, lines 20-23). Ishiyama et al. further teaches that that the acid value of the resin particles should be from 10 to 50 mg-KOH (col. 4, lines 47-51).

Applicant's recitations of specific surfaceness index values, volumetric ratios, compaction ratios, volatility, surface tension, and conductivity are properties of the resin particles. Accordingly, because Ishiyama et al. discloses the same resin particles, the particles of Ishiyama et al. will possess the properties claimed in claims 2, 4, 8-10 and 12-14. A chemical composition and its properties are inseparable. If the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* of anticipation has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

It is noted that there is no teaching of any water content in the resin particles of Ishiyama et al. and that 0% is less than 3%.

It is also noted that no weight is given to the intended use of "for a dermatological composition" recited in claim 1. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction. MPEP 2112.01.

Finally, it is pointed out that for purposes of searching for and applying prior art under 35 USC 102, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to comprising. If an applicant contends that additional steps or material in the prior art are excluded by the recitation "consisting essentially of", Applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of Applicant's invention. See MPEP 2111.03.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 5, 11 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishiyama et al. (USPN 6080519), as applied to claims 1, 2, 4, 6-10 and 12-14 above, and further in view of Hagi et al. (USPN 5976750).

Ishiyama et al. applies as disclosed above. Ishiyama et al. does not teach the specific GSDp, specific molecular weight, specific acid value range, or additional fine particles adhered to the resin particles.

Hagi et al. teaches toner particles comprising a colorant and a binder resin having a volume-mean particle size of 3 to 7 microns and an SF1 of 100 to 130 (col. 3, lines 9-12). It is taught that the resin particles may have inorganic fine particles of a size of 5 to 60 nm externally added in order to increase fluidity of the toner (col. 4, line 33-col. 6, line 40). The number-mean molecular weight of the resin particles is taught to be between 3000 and 6000 and the glass transition temperature is taught to be between 50 and 70° C (col. 6, lines 51-67). It is pointed out that size of the fine particles taught by Hagi et al. are less than half the size of the resin particles.

It would have been obvious to one of ordinary skill in the art at the time of the invention to adhere other small particles to the resin particles of Ishiyama et al. because (1) both Ishiyama et al. and Hagi et al. are drawn to resin particles; (2) both Ishiyama et al. and Hagi et al. are drawn to resin particles of the same size, possessing similar glass transition temperatures, and possessing similar shape factor SF1 values; and (3) Hagi et al. teach that fine particles may be added to the resin particles taught therein. One would have been motivated to add the second smaller particles to the resin particles because, as taught by Hagi et al., they serve to improve the fluidity of the toner.

Furthermore, it would have been obvious to one of ordinary skill in the art to use a resin particle of Ishiyama et al. comprising a number-average molecular weight of between 3000 and 6000, as taught by Hagi et al., because of analogous nature of the two references, as described above. A resin powder with a particle size distribution GSDp of 1.5 or less and an acid value of between 1.0 and 20 mg/KOH/g would have also been obvious to one of ordinary skill in the art because the range of each overlaps with the ranges taught by Ishiyama et al.

The applicant's recitations of specific adhesive strength ratio of the fine particles to the resin particles are properties of said fine particles and resin particles. Accordingly, because Ishiyama et al. in view of Hagi et al. teaches the same resin particles, the particles rendered obvious by Ishiyama et al. and Hagi et al. will possess the properties as claimed in claim 17.

If the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). It has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* of obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Conclusion

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonard M. Williams whose telephone number is 571-272-0685. The examiner can normally be reached on MF 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LMW

SREENI PADMANABHAN
SUPERVISORY PATENT EXAMINER